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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,627	03/01/2002	Vincent Formale	RSW920020013 US1	3717
<div>46270      7590      07/28/2008 (SAUL-RSW) PATENT DOCKETING CLERK IBM Corporation (SAUL-RSW) C/O Saul Ewing LLP Penn National Insurance Tower 2 North Second Street, 7th Floor Harrisburg, PA 17101</div>				
<div>EXAMINER THEIN, MARIA TERESA T</div>				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/087,627

**Applicant(s)**

FORMALE ET AL.

**Examiner**

MARISSA THEIN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3, 9-11, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 9-11, and 19-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

Applicants' "Response to Non-Final Office Action of December 12, 2007 has been considered.

Claims 1 and 9 have been amended. New claims 19-20 are added. Claims 2, 4-8, and 12-18 are cancelled. Claims 1, 3, 9-11, and 19-20 remain pending in this application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 3, 9-11 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the book "Intermediate Accounting", (pages 499-521) (tenth edition) in view of U.S. Patent No. 6,047,267 to Owens et al. and in further view of U.S. Patent No. 2002/0082966 to O'Brien**

Regarding claims 1, 9 and 19-20, Intermediate Accounting discloses classifying an asset as capital or an expensed asset (page 518) comprising: selecting a minimum capitalization value (page 518); receiving purchase data signifying the acquisition of an asset (page 501; page 502); assigning a value of a model of said machine type (page

509); determining a machine type of the acquired asset (page 50; page 502); comparing the value assigned to said machine type of the acquired asset to said minimum capitalization value (page 509; page 514); if the value for the machine type of the acquired asset is greater than or equal to said minimum capitalization value, classifying the asset as a capital asset, and if the value of the machine type of the acquired asset is less than the minimum capitalization value, classifying the asset as an expensed asset (page 518); wherein the instructions corresponding to item comprises weighting said value of each model as a function of predicted purchasing trends of models of machine type of said average calculation (weighted-average accumulated expenditures page 505; pages 519-520 improvements and replacements); the value of the models are derived from the manufacturer's base manufacturing cost (list price page 513); and instructions for weighting weights said value of each model as a function of relative volume of purchasing by said entity of said models (weighted-average accumulated expenditures page 505; pages 519-520 improvements and replacements).

However, Intermediate Accounting does not explicitly disclose assigning with respect to each of a plurality of machine types an average value of a model of said machine type independent of a value of the acquired asset; the models of the machine type; determining a value of the models as of a date that an asset of said machine type as first purchased by said entity; calculating the average value of the models; wherein said asset is at least one of computer hardware or computer software; and computer readable product embodied on computer readable media readable by a computing device.

Intermediate Accounting does disclose valuation of an asset (page 509). To properly reflect cost, assets purchased on long-term contracts are accounted for at the present value of the consideration exchanged between the contracting parties at the date of the transaction ("Deferred Payment Contract" page 509).

O'Brien, on the other hand, teaches assigning with respect to each of a plurality of machine types an average value of a model of said machine type independent of a value of the acquired asset. O'Brien teaches a benchmark value which is a numerical or financial value. The Numerical values can be aggregated, averaged, or otherwise manipulated or processed. (Paragraph 162) The benchmark information system is related to a particular asset against similar information for an entire group of similar assets. The system provides users with the ability to define the group of assets included in a particular analysis. (Paragraph 15) O'Brien further teaches benchmarking pool assets which can be selected on the basis of a shared characteristic, a shared data value for a particular characteristic (paragraph 159). Asset selection for benchmarking purposes should have some relevant characteristic or data value (paragraph 159). The benchmark characteristics include the type of asset (the type or model) paragraph 16). Furthermore, O'Brien teaches the models of the machine type (paragraph 37; paragraphs 160-162; paragraphs 166-167); determining a value of the models (paragraph 37; paragraphs 160-162; paragraphs 166-167), as of the date an asset of said machine type was first purchased by said entity (the date of acquisition purchase; paragraph 37); calculating the average value of the models (paragraph 37; paragraphs

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160-162; paragraphs 166-167); and wherein said asset is at least one of computer hardware or computer software (paragraph 3, a plurality of assets such as computers).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the Intermediate Accounting, to include assigning with respect to each of a plurality of machine types an average value of a model of said machine type independent of a value of the acquired asset; the models of the machine type; determining a value of the models; calculating the average value of the models; and wherein said asset is at least one of computer hardware or computer software, as taught by O'Brien, in order to automatically gather and analyze information relating to the maintenance of a plurality of assets, so as to maximize pertinent and industry wide data to facilitate increasingly informed purchasing decisions in the future (O'Brien paragraph 2).

Owens, on the other hand, teaches a computer readable product embodied on computer readable media readable by a computing device (col. 3, lines 14-18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the Intermediate Accounting, to include a computer readable product embodied on computer readable media readable by a computing device, as taught by Owens, in order to automatically gather and store information.

Regarding claims 3 and 10-11, the combination of Intermediate Accounting and Owens substantially discloses the claimed invention, however, the combination does

not disclose instructions for weighing the value of each model; and a data stream containing the purchaser orders; and reading the machine type out of a data field in the purchase order.

O'Brien, on the other hand, teaches instructions for weighing the value of each model (paragraph 16; paragraph 137; paragraphs 75-77; paragraphs 158-162; paragraphs 163-167); a data stream containing the purchaser orders (paragraph 37; paragraph 156; paragraph 158); and reading the machine type out of a data field in the purchase order (paragraph 37; paragraph 156; paragraph 158).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination, to include instructions for weighing the value of each model; a data stream containing the purchaser orders; and reading the machine type out of a data field in the purchase order, as taught by O'Brien, in order to capture and retain information relating to cost and utilization of an asset in order to facilitate better procurement and other business decisions (O'Brien, paragraph 5).

#### ***Response to Arguments***

Applicant's arguments filed April 11, 2008 have been fully considered but they are not persuasive.

Applicants remark that IA, Owens and O'Brien do not teach "the features of (1) the assets being computer related assets and (2) the particular dates on which the average values of the asset models are determined.

The Examiner does not agree. The combination of IA, Owens and O'Brien does teach the features above, specifically, O'Brien. In paragraph 2, O'Brien teaches a system for benchmarking asset information by automatically gathering, analyzing and delivering information relating to the maintenance of a plurality of such assets to facilitate increasingly informed purchasing decisions in the future (see also paragraph 34). The plurality of assets includes computers (paragraph 3).

Such automatically gathering, analyzing and delivering information relating to the maintenance of a plurality of such assets include computers is considered the assets being computer related assets.

Furthermore, O'Brien teaches acquisition record of the asset by the owner which includes the date of acquisition of asset such as the purchase date (paragraph 37).

Such date of acquisition of asset such as the purchase date is considered the particular dates on which the average values of the assets models are determined.

Applicants remark that IA, Owens and O'Brien do not teach" (1) in calculating the average value of said models of said machine type, the weighting is a function of predicted purchasing trends of models of said machine type (from former claims 4 and 14, respectively) and (2) the value of the models used in the calculations are derived from the manufacturer's base manufacturing cost for said model".

The Examiner does not agree. The combination of IA, Owens and O'Brien does teach the features above, specifically, IA. IA teaches expenditures which include improvements and replacements that is the substitution of an improved asset for an existing one. (Bottom of page 518) Replace is the substitution of a similar asset. The



replacement usually results from a general policy to modernize or rehabilitate a piece of equipment. It is intended to add to the future benefits from an existing asset by decreasing its operating cost, increasing its rate of output or prolonging its useful life. (Pages 519-520) Furthermore, IA teaches the weighted-average accumulated expenditures are calculated based on the period of time or amount of time (page 505). Moreover, the IA teaches "the value of the models used in the calculations is derived from the manufacturer's base manufacturing cost for said model". IA teaches pricing of the list price of a new machine (bottom of page 513).

Such expenditures which includes replacements that is the substitution of a similar asset; and the calculation of the weighted-average accumulated expenditures are considered calculating the average value of said models of said machine type, the weighting is a function of predicted purchasing trends of models of said machine type.

Such list price is considered "the value of the models used in the calculations is derived from the manufacturer's base manufacturing cost for said model".

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARISSA THEIN whose telephone number is (571)272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. Ryan Zeender/  
Supervisory Patent Examiner, Art  
Unit 3627

Mtot /M. T./  
Examiner, Art Unit 3627  
July 20, 2008